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TO:

Name: Examiner D. Brunsman.

Firm: United States Patent
and Trademark Office

Fax No.: 703 872 9049

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Subject: Serial No. 08/544,212
Our Ref.: 01222.0034-01000

FROM:

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Pages (incl. this): 3

Date: February 12, 2001

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PATENT

Attorney Docket No. 01222.0034-01000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David A. Russo et al.

Serial No.: 09/287,664

Filed: April 7, 1999

For: COATING COMPOSITION
FOR GLASS

Group Art Unit: 1755

Examiner: D. Brunsman

Assistant Commissioner for Patents
Washington, D.C. 20231
Sir:

**MEMORANDUM OF ISSUES TO BE DISCUSSED AT ORAL
INTERVIEW AND WHY APPLICANTS BELIEVE AN INTERVIEW
WOULD HELP THE PROSECUTION OF THE APPLICATION**

Applicants' attorney telephoned the Examiner on February 5, 2001 requesting an oral interview, but the Examiner requested that applicants present a memorandum of issues to be discussed at an oral interview and why the interview would help advance the prosecution of the application. Applicants' attorney offers the following remarks in this regard.

**Applicants' Reasons Why an Interview would be helpful
to Advance the Prosecution of the Application**

The assignee of the application has requested a personal interview with the Examiner and will attend the interview if granted.

Applicants' assignee and their attorney believe that because of the complexity of the issues raised in this reissue application, and the multiple rejections and responses exchanged starting with the July 1, 1996 Office Action in the parent copending case, Serial No. 08/544,212, up and through the present October 31, 2000 Office Action, a discussion of the issues at an oral interview will streamline the prosecution and hopefully bring it to a conclusion.

Issues

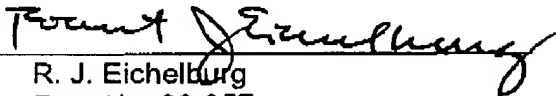
The Examiner states that claims 28-32 are barred by the recapture doctrine in view of Ball Corp. v. United States, 729 F.2d 1429, 221 U.S.P.Q. 289, 295 (Fed. Cir. 1984) holding that "the recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were cancelled from the original application." Applicants attorney will show that these claims were not cancelled from the original application.

Applicants therefore respectfully request that the Examiner grant an oral interview.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


R. J. Eichelburg
Reg. No. 23,057

Dated: February 12, 2001

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